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EXAMINER

PEPITONE, MICHAEL F

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

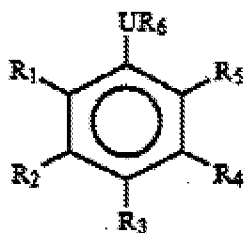
The time period for reply, if any, is set in the attached communication.

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Response to Arguments

The rejection of claims 1 and 3-8 based on Köhler *et al.* (US 5,387,718) and Grab *et al.* (EP 1264547) is maintained for reason of record and the following response [see Official action 1/7/09].

Köhler *et al.* (US '718) discloses alkylphenyl alkyl thioethers having the general formula:



where U represents O or S; and

R₁-R₆ each independently represent an alkyl or aryl group, but R₁-R₅ may each independently represent a functional group other than these, including, e.g., but not limited to, —COOR, —NO₂, —NH₂, —O—CH₂—CH₂—OH, —OH, —CHO, or -halogen; further

R₁-R₅ may be bridged by suitable bifunctional substituents, such as, e.g., —(CH₂)_x—, or —(CH₂)_x—Z—(CH₂)_y— (where Z represents a hetero atom; x=0-7, and y=0-7), or preferably unsaturated substituents such as are characteristic of anellated ring systems, e.g. (but not limited to) naphthyl, phenanthryl, anthracenyl, quinolyl, isoquinolyl, or indolyl.

(1:15-42); wherein U=S,

R₆=Me, R₃=alkyl having a fused C₀₋₇ cycloalkyl ring R₁=R₂=R₄=R₅=H (2:60-67; 3:6-12; 4:48-46; 6:50-59). Spicy and anisic odor notes would implicitly be achieved from structures corresponding to instant claim 1.

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While the preferred embodiments {ex. 1-2 and 4-7} do not specifically depict the structures of instant claims 1 and 8, the general formula discloses such compounds. If one of ordinary skill in the art is able to “at once envisage” the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be “at once envisaged.” One may look to the preferred embodiments to determine which compounds can be anticipated. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). The reference must be considered for all that it discloses and must not be limited to preferred embodiments [see MPEP 2123].

“Köhler *et al.* (US ‘718) discloses alkylphenyl alkyl thioethers {compounds from the general formula} to be used as fragrances (5:42-45). Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) [see MPEP 2112.01].

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Grab *et al.* (EP '547) was relied on for flavor and fragrance compositions {household products} containing 1-mercapto-1-phenylalkanes which have a natural spicy character (¶ 1-2) and such compounds provide household products with a clear natural spicy character without any attendant dominant roasted note or accompanying pungent and putrid notes (¶ 5).

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PEPITONE whose telephone number is (571)270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

MFP
10-March-09